

Serial No. 09/749,227

Page 4

**REMARKS**

In the Office Action of November 21, 2003, the Examiner rejected the claims 1-6 and 15 as reciting subject matter not enabled and as indefinite. The Examiner further rejected claims 1-6, 9 and 15 as obvious, over Reedhead in view of the stringing instructions of the MacGregor Bergelin Longstring racquet found in The Stringer's Digest (MacGregor).

The Applicants respectfully traverse the present rejections.

**Support for the New Claims**

The Applicants submit that new claims 16 - 18 are supported by the above-identified application as originally filed.

For instance, new claims 16 and 17 add to original claims 1 and 9, respectively, (x) the word "undistorted" to the word "frame" and (y) the phrase "said strings having a tension of between about 55-65 pounds without distorting said frame". Paragraph 0014 describes the invention as not being distorted and states that the string tension is about 55-65 pounds. Thus, each limitation of these new claims is well supported in the above-identified application as originally filed.

New claim 18 adds the limitation that the string segments are substantially outside the handle body. This aspect of the claimed subject matter is illustrated in for instance Figure 1. Figure 1 shows a strung racquet according to the present invention. As can be seen in Figure 1, the strings are substantially outside of the handle body. Thus, this limitation is well supported in the above-identified application as originally filed.

**The Objection to the Specification**

In paragraph 2, page 2, of the present Office communication, the Examiner again alleges that "there is no description in the originally filed specification of strings being in a non-distorted shape". (Emphasis in original). The Applicants respectfully disagree.

Notwithstanding his assertion that the specification does not describe the strings being in a non-distorted shape, the Examiner appears to acknowledge that the originally filed specification discloses that the racket frame is not distorted. See e.g., the Abstract and ¶¶ 0013 & 0014. The Applicants respectfully submit that if the racket frame of the present invention is not distorted, then inherently and inevitably, the strings are not distorted. The Applicants further

Serial No. 09/749,227

Page 5

submit that one of ordinary skill would have understood, from at least the disclosure in the present specification, that since the frame is not distorted, the strings are similarly not distorted.

In view of the inherent result that the strings are not distorted that inevitably flows from the racket disclosed in the present application, the present application provides a sufficient antecedent basis for the claimed subject matter (and provides a written description of the same).

Indeed, the Applicants note that the Examiner has not made any showing which shows that the strings of the disclosed racket are in any way distorted. As the CCPA stated:

[W]e are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.

*In re Wertheim*, 191 U.S.P.Q. (BNA) 90 (C.C.P.A. 1976). Thus, until such time as the Examiner can proffer a *prima facie* showing that an undistorted racket, as described in the present specification, produces distorted strings, the Examiner must withdraw the present objection.

#### **The Section 112 Rejections**

##### ***Alleged lack of enablement***

In ¶ 3, the Examiner rejected the claimed subject matter as not enabled. However, the Examiner has not made any showing as to why one of ordinary skill, using the above-identified specification, could not practice the subject matter claimed. Because the Examiner has not made any showing, the Examiner has not made a *prima facie* showing that one of ordinary skill, using the above-identified specification, could not practice the subject matter claimed. For this reason alone, the present rejection must be withdrawn.

Instead of demonstrating, or providing reasoning as to, why one of ordinary skill, using the above-identified specification, could not practice the subject matter claimed, the Examiner states that there is no description of the strings being in a non-distorted shape. Even if true, that fact would not support the present rejection.

Moreover, there is no requirement under section 112 that the Applicant provide *ipsis verbis* support for a claim term. Rather, it is sufficient that a claim limitation is inherent in the disclosure. See *In re Smythe*, 178 U.S.P.Q. (BNA) 279 (C.C.P.A. 1973).

Serial No. 09/749,227

Page 6

For the above reasons, the Applicants respectfully submit the lack of enablement rejection must be withdrawn.

***Alleged indefiniteness***

With respect to the Examiner's asserted indefiniteness rejection, the Applicants respectfully note that the Examiner has not made a *prima facie* showing that one of ordinary skill cannot ascertain the metes and bounds of the claimed subject matter using the specification as a guide. Indeed, the Applicants respectfully submit that one of ordinary skill following the directions given in the present specification would clearly understand the metes and bounds of the claimed subject matter. Thus, this claim limitation is not indefinite and the rejection must also be withdrawn.

The Applicants respectfully submit that one of ordinary skill would not, in the context of the present application, understand a string tension of about 55-65 pounds to be a string distortion. Rather, especially in view of the teaching that the frame is not distorted, the Applicants respectfully submit that one of ordinary skill would understand that -- in the context of the above-identified application -- distortion is measured from the strung racket in its rest position. With that understanding, the Applicants respectfully submit that one of ordinary skill could ascertain the metes and bounds of the claims. Therefore the claims are sufficiently definite and the present rejection must be withdrawn.

**The Prior Art Rejections**

As indicated above, the Examiner also rejected claims 1-6, 9 and 15 as obvious, over Reedhead in view of the stringing instructions of the MacGregor Bergelin Longstring racquet found in The Stringer's Digest (MacGregor).

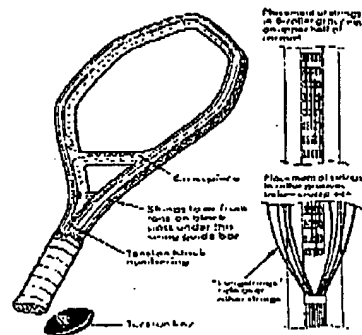
The Applicants also traverse the Examiner's prior art rejections.

In the first instance, the Applicants note that the new reference is incomplete. Consequently, the reference is *prima facie* not a proper reference. Specifically, the Applicants note that the Examiner has selected pages 78-79 out of The Stringer's Digest. However, page 78 expressly states that there is material information on at least one other page. Specifically, page 78 states "Note: also see information of page 76". Without at least page 76, the Examiner can not establish that page 76 does not negate whatever he says the reference teaches. Thus, for this reason alone, the present rejection must be withdrawn.

Serial No. 09/749,227  
Page 7

Next, the Applicants note that the present rejection relies upon a combination of references, namely the Reedhead patent with The Stringer's Digest. The Reedhead patent is concerned with a "Throatless Tennis Racquet". See e.g., the title and the first line of the Abstract. It is the Applicants understanding that a throatless tennis racquet does not have a "crosspiece". See e.g., U.S. Patent No. 4,196,901 to Durbin.

In marked contrast to Reedhead's throatless racquet, the racquet described in The Stringer's Digest clearly has a throat or crosspiece. Because the racquet of Reedhead does not have a throat and the racquet of The Stringer's Digest has a throat, the two references are inconsistent. The Applicants also note that the alleged basis for combining these references is that "MacGregor discloses a similar adjustable-tension racquet to Reedhead". Office communication at 4.



However, because the racquets disclosed in each of these references are markedly different from each other -- the racquet of Reedhead is throatless whereas the racquet of The Stringer's Digest has a crosspiece -- the references are inconsistent. Because of this inconsistency, there is no basis for combining these references under the standards of section 103. Consequently, the Examiner has not made a *prima facie* showing of obviousness. For this reason alone, this rejection must be withdrawn.

The Applicants further note that both of the cited references -- the Reedhead patent and The Stringer's Digest -- tension all of their string segments at once by turning a key in the handle. Such tensioning processes necessarily require that the racquets disclosed in the cited references have a substantial portion of their strings in the handle of their racquets. In marked contrast to the racquets disclosed in the cited references, substantially none of the string of the racquets of the claimed subject matter is within the handle of the claimed subject matter.

Serial No. 09/749,227  
Page 8

Further evidence of this substantial difference between the claimed subject matter and the cited references is found by comparing the length of string used to string the racquets. The Stringer's Digest states that stringing uses two lengths of 27 feet for a total of 54 feet of string. Last paragraph on page 78. In contrast, the racquet of the claimed subject matter uses a single length of 40 feet. See paragraph 0020. Thus, the racquet of the claimed subject matter uses at least 25% less string. Clearly, such of difference in the amount of string used is an unexpected difference between the racquets of the cited references and the claimed subject matter which negates any *prima facie* showing of obviousness.

The tensioning of all their string segments at once as described in the cited references leads to a unique set of forces that are not present in the claimed subject matter where the string segments are tensioned as they are strung. The racquets disclosed in the cited MacGregor and Reedhead references, are tensioned by turning a key in the handle. E.g., key 50 in Figure 2 of Reedhead. Turning the tension key in the cited references creates forces in the racquet that flex, or distort, the racquet.

In contrast, the strings of racquet of the claimed subject matter are tensioned as the racquet is strung. This tensioning process used to produce the racquet of the claimed subject matter imparts to the frame of the claimed subject matter forces that are quite different from the forces imparted to the frames of the racquets disclosed in the cited references. The tensioning forces in the claimed subject matter do not distort -- flex -- the racquet.

The Applicants respectfully submit that the claimed subject matter in which the strings (and frame) are not distorted cannot be rendered obvious by any combination, for instance that of the Reedhead patent with The Stringer's Digest, that distorts -- flexes -- the racquet.

With respect to distortion -- flexion -- of the frame, we note the claimed subject matter is adapted "to completely eliminate distortion." E.g., Claim 1. This subject matter is in marked contrast to Reedhead, which concludes by summarizing its teachings as a:

novel configuration of the stringing of the present invention in combination with the novel racquet head configuration provide *increased flexing* of the racquet . . . [T]he present invention . . . provide[s] a tennis racquet having *increased lateral and longitudinal flexing* characteristics. Col. 6, lines 10 - 29 (emphasis added).

Serial No. 09/749,227  
Page 9

The Applicants further note that the Examiner has clearly misunderstood the claimed subject matter. Specifically, the Examiner's comments appear to be directed to a condition in which the strings are slack. Office communication at 4. However, the claimed subject matter is a racquet suitable for use in playing, for example tennis. Therefore, as noted above, the strings -- in the claimed subject matter -- are tensioned -- sequentially -- [to about 55-65 pounds according to ¶ 0014]. Thus, the Applicants respectfully submit that the combination of the Reedhead patent with The Stringer's Digest is not relevant to the patentability of the claimed subject matter because the combination addresses slack, but not tensioned, strings.

In sum, the Reedhead patent expressly discloses a racket that is not distortion free. Rather, the Reedhead patent expressly discloses a racquet head having increased flexing - distortion. Consequently, the Reedhead patent does not disclose the claimed constant tension, distortion free subject matter. Therefore the present rejection must be withdrawn and the claims allowed.

In view of the above, and other arguments, the Applicants further respectfully submit that when the cited art and the rejected claims are properly construed, the claimed subject matter is not obvious. Thus, the present rejection must be withdrawn and the claims allowed.

Respectfully submitted,  
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